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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

BREVARD, MAERENA W

ART UNIT PAPER NUMBER

3727

DATE MAILED: 08/01/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/903,426

Applicant(s)

GALBRAITH ET AL.

Examiner

Maerena W. Brevard

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 11, 13, 15-19 and 21-23 is/are rejected.
- 7) ☒ Claim(s) 2-10, 12, 14 and 20 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4. 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 22 and 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 22 and 23 are indefinite and unclear since they both are directed at a method of mounting a saddlebag, while they depend from a claim that provides a method of opening a saddlebag.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

4. Claims 17-19 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Niemi et al.

In accordance with MPEP 2111, Niemi discloses a carrier structurally meeting the limitations and capable of being used as a motorcycle saddlebag comprising:

- A lid (22);
- A body (24);
- A hinge assembly (48, 50, 52, 53, 54, 55) coupling the lid to the body;
- A biasing member (66) interconnecting the lid and body;
- The biasing member biasing the lid toward an open position (Figure 2);
- A latch (36, 38) interconnecting the lid and body;
- The biasing member is a gas spring (Column 3, line 63);
- A locking assembly (41) including a latch mounted to the lid, a push button slidably mounted to the body, and a hook pivotally mounted to the push button by a pin (Figure 1), wherein depressing the push button causes the hook to pivot about the pin (Column 3, lines 18-23).

Regarding claim 21, the method for opening the carrier is inherent with the use, to the degree claimed.

5. Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Cousins et al.

Cousins discloses a motorcycle saddlebag comprising:

- A body (11);
- A lid (22);
- A hinge assembly (25) interconnecting the body to the lid; and
- The hinge assembly including a first mounting member mounted to the inner surface of the body, a second member mounted to the inner surface of the lid

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(Figure 1), and a coupling assembly (25A) pivotally coupling the first and second mounting members (Column 2, lines 23-29).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 11, 13, 15, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over LaRochelle.

LaRochelle discloses a motorcycle saddlebag comprising a body defining a cavity (19), the body having a lip (31) formed integrally with the body and defining a mouth of the cavity, a gasket (32) positioned on the body lip, a lid (26) having a lid lip (33), and the gasket sandwiched between the lid lip and the body lip when in a closed position (Figure 7), but does not teach a chrome plating adhered to the external surface of at least one of the lid and body or the body being made from injection molding. It would have been obvious to adhere chrome plating to the external surface. Doing so would provide a more aesthetically pleasing container. It also would have been obvious to make the saddlebag by injection molding, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

Regarding claims 15 and 16, the hinge has a pivot axis and a mechanism for moving the pivot axis during opening and closing which includes means for moving the lid in a substantially

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translational manner away from the body and means for pivoting the lid with respect to the body, to the degree claimed.

8. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over LaRochelle in view of Vandergriff.

LaRochelle discloses a motorcycle saddlebag comprising a body (19), a lid (26), and a hinge assembly (27), but does not teach the hinge assembly completely enclosed within the cavity when the lid is in a closed position. However, Vandergriff teaches a hinge assembly (10) capable of interconnecting the body to the lid comprising a first mounting member mountable on the inner surface of the body, a second mounting member mountable to the inner surface of the lid, and a coupling assembly (70) pivotally coupling the first and second mounting members to each other, wherein the hinge assembly would be completely enclosed within the cavity of the lid in the closed position. It would have been obvious to replace the outer hinge assembly of LaRochelle with the hinge assembly of Vandergriff. Doing so would provide a gapless and self-sealing hinge assembly to prevent moisture from entering into the cavity. Also, it would make the saddlebag more aesthetically pleasing.

Allowable Subject Matter

9. Claims 2-10, 12, 14, and 20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

10. Claims 22 and 23 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

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Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Powell et al., Kaspar et al., and Haslett are cited for carriers capable of carrying on a motorcycle. Morgan and Soss are cited for hinge assemblies.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maerena W. Brevard whose telephone number is 703/305-0037. The examiner can normally be reached on M-Th; 8:00 AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lee W. Young can be reached on 703/308-2572. The fax phone numbers for the organization where this application or proceeding is assigned are 703/872-9302 for regular communications and 703/746-4224 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703/305-0037.


Maerena W. Brevard
Patent Examiner